

REMARKS

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

Claims 1, 4, 13, 21, 23, 27 and 29 are amended. Claim 30 is added. Claims 1-6, 11-15, 19-27, 29 and 30 are pending.

I. Rejection under 35 U.S.C. § 103

In the Office Action, at page 5, numbered paragraph 5, claims 1-6, 11-15, 19-27 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 10114950 to Goertz Werner ("Werner") in view of U.S. Patent No. 5,920,826 to Metso et al. This rejection is respectfully traversed because the combination of the teachings of Werner and Metso does not suggest:

storing the received SMS short messages in a memory region of the facsimile machine or the multifunctional device operating in the wired network according to a user selection;

printing the received SMS short messages according to the user selection; and

deleting the printed SMS short messages according to the user selection after the printing,

as recited in amended independent claim 1.

Werner discusses receiving a short message SMS by a fax machine FAX, which is processed further in the FAX machine with the help of a Fixed network-SMS-protocol stack implemented in the Fax machine FAX, which is then displayed on a display unit of the fax machine and/or is printed on the paper roll of the fax machine FAX.

Werner does not suggest storing the received SMS short message in a memory region of the fax machine according to a user selection. Further, Werner does not suggest printing the short message according to the user selection and deleting the short message according to the user selection. The Examiner indicates that Metso makes up for the deficiencies in Werner. The Applicants respectfully disagree.

Metso discusses that a local mobile terminal is able to optionally store text messages which can be transmitted or received over a radio telephone network via the local mobile terminal. Metso discusses that when an SMS message has been received, the mobile station displays the message and the user can either read the message straight away or store the message for reading later. The active message can also be deleted by the user. Metso further

discusses that a selected message may be printed on a default printer for the computer and that messages may be deleted.

First, Metso is directed to storing, printing and deleting SMS short messages received in a non-wired mobile network. The field of Metso and that of Werner are distinct – Werner is directed to receiving and sending messages over a fixed network, while Metso is directed to receiving and sending messages over a mobile network. Thus, the printing, storing and deletion in Metso of messages received over a mobile network is not able to be incorporated into the fixed network of Werner. Wired and wireless networks operate in distinct ways, as discussed at paragraph 0005 of the present specification, for example (“However, in a wired telephone having an SMS function, short messages received from an SMSC can be confirmed on a display window attached to the telephone, and the received short messages cannot be printed. Thus, there is difficulty in managing received SMS short messages [emphasis added].”).

M.P.E.P. § 2143.01 states that “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Here, combining the wireless network of Metso with the fixed network of Werner would change the principle of operation of the prior art invention being modified (Werner) because Werner cannot operate in accordance with both a wired and a mobile network. Thus, the teachings are not sufficient to render the claims *prima facie* obvious.

In addition, Metso does not suggest storing received SMS short messages in a memory region of the facsimile machine or the multifunctional device operating in the wired network according to a user selection. The short messages in the mobile network discussed in Metso suggest that the user can either read or store the messages for reading later. However, as Metso operates in a wireless network, Metso does not suggest storing the short messages in a memory region of a fax machine or multifunctional device operating in a wired network according to a user selection.

In Werner, the short message SMS is able to be processed in a fixed network SMS-protocol stack implemented in the fax machine FAX. The fixed network SMS-protocol stack is not a memory region of a fax machine or multifunctional device. Further, the SMS messages in Werner are not stored according to a user selection (i.e., selectively stored). Werner only discusses either displaying the message or printing the message. Werner does not suggest that

a user is able to make a selection and therefore either store or not store a message in a memory region. While Metso discusses that the user may read or store the SMS message, Metso does not suggest that the message is received at a facsimile machine or multifunctional machine operating in a wired network, where the machine includes a memory region capable of storing specific messages and then printing the messages and/or deleting the messages that have been stored.

Further, while Metso discusses printing and deleting messages according to a user's selection, Metso does not suggest printing and deleting messages according to a user's selection that have been stored in a memory region of a facsimile machine or multifunctional machine that operates in a wired network.

In addition, the cited motivation does not suggest how or why the storing, printing and deleting functions of Metso, which occur at a machine operating in a wireless network, could be incorporated into a fax machine operating in a wired network that does not include a storage capable of storing the messages so that the user would be able to make specific decisions about the messages (i.e., printing and/or deleting the stored messages).

The benefit the present invention according to claim 1, for example, provides is that since the SMS short messages are selectively stored, printed and deleted, an area occupied by the SMS short messages in the memory unit of the fax machine, which operates in the fixed network, can be minimized, a waste of resources can be eliminated and the SMS short messages can be managed in a document format.

Therefore, as the combination of the teachings of Werner and Metso does not suggest "storing the received SMS short messages in a memory region of the facsimile machine or the multifunctional device operating in the wired network according to a user selection; printing the received SMS short messages according to the user selection; and deleting the printed SMS short messages according to the user selection after the printing," as recited in amended independent claim 1, claim 1 patentably distinguishes over the references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Also, the combination of the teachings of Werner and Metso does not suggest "storing the received SMS short messages in a predetermined memory region of the facsimile machine or the multifunctional device operating in the wired network according to a user selection according to a user selection; and printing the stored SMS short messages according to the user selection," as recited in amended independent claim 13. Thus, claim 13 patentably

distinguishes over the references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Further, the combination of the teachings of Werner and Metso does not suggest “receiving short messages from the SMS through a wired network, storing the received SMS short messages in a memory region of the printing apparatus operating in the wired network and printing the received and stored SMS short messages,” as recited in amended independent claim 21. Thus, claim 21 patentably distinguishes over the references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

In addition, the combination of the teachings of Werner and Metso does not suggest “an SMS interface receiving short messages from the SMS through a wired network and storing the received SMS short messages in a memory region of the printing apparatus operating in the wired network according to a user selection; [and] a printer printing the received and stored SMS short messages according to the user selection,” as recited in amended independent claim 23. Thus, claim 23 patentably distinguishes over the references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Additionally, the combination of the teachings of Werner and Metso does not suggest “a programmed computer processor according to a user selection setting up a call to an SMS center, receiving and storing SMS short messages through a wired network from the SMS center in a memory of the printing device operating in the wired network, selectively providing the received SMS short messages, and printing the stored SMS messages according to the user selection to allow managing the received SMS short messages in a document format,” as recited in amended independent claim 27. Thus, claim 27 patentably distinguishes over the references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Further, the combination of the teachings of Werner and Metso does not suggest “storing the received SMS short messages in a predetermined memory region of the facsimile machine or the multifunctional device operating in the wired network according to a user selection; and printing the received and stored SMS short messages according to the user selection,” as recited in amended independent claim 29. Thus, claim 29 patentably distinguishes over the

references relied upon. Further, combining Werner and Metso would change the principle of operation of Werner. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

II. New Claim

New claim 30 recites that "the wired network is a public switched telephone network." Combining the references relied upon does not suggest such. Therefore, it is respectfully submitted that new claim 30 patentably distinguishes over the references relied upon.

Conclusion

In accordance with the foregoing, claims 1, 4, 13, 21, 23, 27 and 29 have been amended. Claim 30 is added. Claims 1-6, 11-15, 19-27, 29 and 30 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By:



Kari P. Footland
Registration No. 55,187

Date: August 7, 2008

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501